REMARKS

This Response is submitted in reply to the Non-Final Office Action dated September 15, 2009, and in accordance with the Telephone Interview conducted on November 2, 2009. Claims 1 to 5, 7 to 9, 12 to 15, 19 to 25, 27 to 29, 31 to 38, 42 to 45, 49 to 52, 55 to 56, 59 to 60, 63 to 64 and 67 to 68 have been amended. Support for these amendments can be found in at least paragraphs [0061] to [0064] of the specification of the present application. Claims 10, 16, 30 and 41 were previously canceled. No new matter has been added by these amendments. Please charge Deposit Account No. 02-1818 for any fees due in connection with this Response.

The Office Action rejected Claims 1 to 9, 11 to 15, 17 to 29, 31 to 40 and 42 to 70 under 35 U.S.C. §112, second paragraph. Specifically, page 3 of the Office Action stated that:

> [t]he claimed invention suggests that the player might be awarded by both classes of the awards in the same invention, while the specification indicates that the two classes doe not coexist in the same embodiment.

Applicant respectfully disagrees and submits that, as discussed during the interview, in certain embodiments, players are provided a total award based on any award associated with any of the locations the symbol has moved to <u>and</u> based on the determined number of locations the symbol has moved to before a terminating condition occurs. Additionally, Applicant submits that support for these embodiments can be found in at least paragraphs [0018], [0021], [0074] and [0075] of the specification of the present application.

Paragraph [0018] of the present application discloses:

> [i]n another embodiment, the award provided to the player is based on a combination of the number of locations the player symbol moves to before the player symbol reaches the destination location and the awards associated with any of the locations the player symbol is moved to.

Paragraph [0021] of the present application discloses:

> [i]n an alternative embodiment, the less locations the player's symbol moves to before reaching a location that is not between the two predetermined locations, the greater the award that will be provided to the player. In another embodiment, the award provided to the player is based on a combination of the number of locations the player symbol moves to

before the player symbol is moved to a location that is not between the two predetermined locations and any award provided for any of the locations the player symbol is moved to.

Paragraph [0074] of the present application discloses:

[i]n one embodiment, the player is not provided any award associated with each location the player symbol is moved to, but rather the player is provided an award based on the number or amount of locations the symbol is moved to before the game ends. In this embodiment, the greater the number of locations the player symbol is moved to during the play of the game, the greater the award provided to the player at the end of the game. For example, if the player symbol is moved to four locations before player symbol reaches the destination location, the player is provided an award of ten credits. On the other hand, if the player symbol is moved to eight locations before the player symbol reaches the destination location, the player is provided an award of fifty credits. In another embodiment, the player is provided an award for the amount of different locations the symbol is moved to before the game ends. In an alternative embodiment, the less locations the player's symbol moves to before reaching the destination location, the greater the award that will be provided to the player. In this embodiment, the player's objective is to reach the destination location with as little moves as possible because the less moves it takes to reach the destination location, the greater the award. In another embodiment, the award provided to the player is based on a combination of the number of locations the player symbol moves to before the player symbol reaches the destination location and the awards associated with any of the locations the player symbol is moved to.

Paragraph [0075] of the present application discloses:

[i]n an alternative embodiment of the present invention (not shown), the player is not provided an award for the symbol reaching or moving beyond the destination location, but rather, the player is provided an award based on how many locations between two predetermined locations, such as the start location and the destination location, that the symbol is moved to before the symbol reaches or is moved beyond one of the two predetermined locations. In this embodiment, unlike the embodiments described above, if the symbol is relocated or moved back to or back beyond the start location (i.e., by a setback condition), the game ends. In one embodiment, the player is provided any award associated with each location the player symbol is moved to. In another embodiment, the award provided to the player is based on the number of locations the player symbol is moved to before the player symbol is moved to a location that is not between the two predetermined locations. In an alternative embodiment, the less locations the player's symbol moves to before reaching a location that is not between the two predetermined locations,

the greater the award that will be provided to the player. In another embodiment, the award provided to the player is based on a combination of the number of locations the player symbol moves to before the player symbol is moved to a location that is not between the two predetermined locations and any award provided for any of the locations the player symbol is moved to.

Accordingly, Applicant submits that the rejection should be withdrawn.

The Office Action rejected Claims 1 to 9, 11 to 15, 17 to 29, 31 to 40, 42 to 52, 55 to 56, 59 to 60, 63 to 64 and 67 to 68 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,767,283 to Weiss ("Weiss") in view of U.S. Patent No. 6,409,172 to Vancura ("Vancura"). Applicant disagrees with and traverses these rejections for at least the following reasons.

Weiss discloses a gaming device having "a primary display and a plurality of symbols on the primary display which leads to a first bonus . . . [t]he first bonus is a serpentine path over which a character must traverse in order to achieve a second bonus." Weiss, Abstract. Specifically, column 1, lines 50 to 58 of Weiss discloses:

> [a] first bonus event involves a playing path that a simulated character such as a dog is required to traverse. The number of steps that the simulated character takes is determined by a spinner located in a video screen which the player activates, preferably by touching. In this first bonus event, preferably a certain number of spins are allocated the player. Each time the character lands on a spot on the path which correlates to a credit value, that credit value is posted to the player's account.

Vancura discloses a gaming device that "establish[es] a plurality of paths, each of which have a plurality of squares including a start square, an end square, and a plurality of value squares. . . awarding the player the values associated with squares landed upon." Vancura, Abstract. More specifically, column 7, lines 41 to 47 of Vancura discloses that:

> certain squares may allow players to acquire items that may later be exchanged for value. For example, consider a dessert-themed game in which predetermined squares allow the player to accumulate scoops of ice cream. Upon completion of the path, the player may receive an additional award based upon the number of scoops of ice cream collected.

Amended independent Claim 1 includes, among other elements, a display device operable to display: (i) a plurality of locations including a first location and at least one setback condition location, wherein the plurality of the locations form a path, and (ii) at least one symbol adapted to make a plurality of moves to a plurality of the locations, and at least one memory device which stores a plurality of instructions executable by the processor to cause the processor to operate with the at least one input device and the display device, for each play of a game, to: (a) cause the symbol to move to one of the locations along the path toward the first location, (b) for each occurrence of the symbol moving to the at least one setback condition location, randomly determine whether to relocate the symbol to one of the locations along the path further from the first location, (c) if the random determination is to relocate the symbol to one of the locations along the path further from the first location, move the symbol to one of the locations along the path further from the first location, (d) determine a number of each of the locations the symbol has moved to, (e) repeat steps (a) to (d) until the symbol moves to the first location, and (f) provide a player an award based on the determined number of locations the symbol has moved to before the symbol moves to the first location, the award being separate from any value which is associated with any of the locations prior to the symbol being moved to any of the locations.

Applicant submits that neither Weiss or Vancura individually nor the gaming device resulting from the combination of Weiss and Vancura anticipate or render obvious, for each play of a game, for each occurrence of the symbol moving to the at least one setback condition location, randomly determine whether to relocate the symbol to one of the locations along the path further from the first location, and if the random determination is to move the symbol to one of the locations along the path further from the first location, move the symbol to one of the locations along the path further from the first location.

Weiss discloses a space along a playing path in a bonus game, which if landed on by a character, signals an end to the bonus game. Specifically, column 1 lines 58 to 61 of Weiss disclose that:

[a]long the playing path are spaces which, if the character advances and stops thereat, signals the end of the bonus event. These spaces which indicate the end of the bonus event are entitled "Go Home".

The Office Action appears to interpret the "Go Home" feature of Weiss as moving the symbol to one of the locations along the path further from the first location (for each occurrence of the symbol moving to the setback condition) of amended independent Claim 1. Specifically, page 5 of the Office Action stated that Weiss teaches:

[r]elocating the symbol to one of the locations along the path further from the first location if the symbol moves to the location associated with the setback condition, until the symbol moves to the first location (e.g., (1) repeatedly playing the bonus game, each time ultimately having a "Go Home" outcome, until the last play results in achieving an "Easy Street" game, and subsequently cashing out...

Applicant submits that, in Weiss, each occurrence of the character landing on a "Go Home" space results in the ending of the bonus event. That is, in Weiss, after the character lands on the "Go Home" space, a random determination is not made to determine whether to end the bonus event.

Additionally, page 11 of the Office Action stated that:

[v]ancura describes landing on a setback location that causes the player's symbol to move backward one or more spaces (see at least 7:22-25)...It would have been obvious to one of ordinary skill in the art at the time of invention to modify Weiss to include non-termination setback condition of Vancura in order to provide players a chance to continue playing the bonus game even though the player's symbol has experienced a setback condition.

Column 7, lines 22 to 25 of Vancura disclose that:

[i]t is also within the scope of this invention to have designated squares act to move the player to other squares. This may be accomplished, e.g., via "Move ahead 3 squares" or "Go back 1 square" types of instructions.

Applicant submits that regardless of whether Vancura discloses a designated square which acts to move the player to another square (interpreted by the Office Action as a non-terminating setback condition), Vancura does not cure the deficiencies of Weiss. In Vancura, the player is moved to another square for each occurrence of the player landing on the designated square. Thus, Vancura does not anticipate or render

obvious for each occurrence of the player landing on the designated square, randomly determining whether to move the player to another square. Therefore, Applicant submits that the gaming device resulting from the combination of Weiss and Vancura does <u>not</u> anticipate or render obvious (without the benefit of improper hindsight reconstruction) for each play of a game, for each occurrence of the symbol moving to the at least one setback condition location, randomly determine whether to relocate the symbol to one of the locations along the path further from the first location, and if the random determination is to relocate the symbol to one of the locations along the path further from the first location, move the symbol to one of the locations along the path further from the first location.

On the other hand, amended independent Claim 1 includes, amongst other elements, at least one memory device which stores a plurality of instructions executable by the processor to cause the processor to operate with the at least one input device and the display device, for each play of a game, for each occurrence of the symbol moving to the at least one setback condition location, randomly determine whether to move the symbol to one of the locations along the path further from the first location, and if the random determination is to relocate the symbol to one of the locations along the path further from the first location, move the symbol to one of the locations along the path further from the first location.

Additionally, Applicant submits that, as discussed during the interview and as discussed in the previously submitted Response to Office Action dated August 4, 2009, neither Weiss or Vancura individually, nor the gaming device resulting from the combination of Weiss and Vancura anticipate or render obvious providing a player an award based on the determined number of locations the symbol has moved to before the symbol moves to the first location, the award being separate from any value which is associated with any of the locations prior to the symbol being moved to any of the locations.

Applicant respectfully reiterates that in Vancura, if the movable indicia (interpreted by the Office Action as the symbol of independent Claim 1) lands on a predetermined square, the player accumulates a scoop of ice cream. In Vancura, the

player may later exchange the accumulated scoops of ice cream for a value. Under this interpretation of Vancura, the player only accumulates a scoop of ice cream when the movable indicia lands on one of the predetermined squares associated with a scoop of ice cream. Thus, in Vancura, a movable indicia may land on a square other than a predetermined square associated with a scoop of ice cream, and no scoops of ice cream would be accumulated for the player. That is, in Vancura, each time the movable indicia moves to a location that is not a predetermined square associated with a scoop of ice cream, the number of scoops of ice cream accumulated does not increase. Hence, Vancura does not count each location visited by the movable indicia in the determination of the additional award based on the number of scoops of ice cream accumulated.

During the interview, the Examiner pointed to column 7, lines 41 to 42 of Vancura, which state that "certain squares may allow players to acquire items that may later be exchanged for value", for anticipating an award based on the determined number of locations the symbol has moved to before the symbol moves to the first location of amended independent Claim 1. The Examiner stated that the term "certain" means "at least one" which may be interpreted to mean "each". Applicant respectfully disagrees and submits that the term "certain", as it is used in this instance of Vancura, does not mean "each". Thus, Applicant submits that Vancura does not count each location visited by the movable indicia in the determination of the additional award, as discussed above. Weiss does not cure this deficiency of Vancura.

On the other hand, amended independent Claim 1 includes, amongst other elements, at least one memory device which stores a plurality of instructions executable by the processor to cause the processor to operate with the at least one input device and the display device, for each play of a game, to provide a player an award based on the determined number of locations the symbol has moved to before the symbol moves to the first location, the award being separate from any value which is associated with any of the locations prior to the symbol being moved to any of the locations.

For at least these reasons, amended independent Claim 1 is patently distinguished over Weiss and Vancura, and is in condition for allowance.

Claims 2 to 4 depend directly or indirectly from amended independent Claim 1 and are allowable for the reasons given with respect to amended independent Claim 1 and because of the additional features recited in these claims.

Amended independent Claims 5, 9, 15, 21, 25, 29, 34, 38, 45, 51, 55, 59, 63 and 67 each include certain similar elements to amended independent Claim 1. For reasons similar to those discussed above with respect to amended independent Claim 1, amended independent Claims 5, 9, 15, 21, 25, 29, 34, 38, 45, 51, 55, 59, 63 (and dependent Claims 6 to 8, 11 to 14, 17 to 20, 22 to 24, 26 to 28, 31 to 33, 35 to 37, 39 to 40, 42 to 44, 46 to 50, 52, 56, 60, 64 and 68) are each patentably distinguished over Weiss and Vancura and are each in condition for allowance.

Regarding Claims 9 to 20, 29 to 50, 55 to 58 and 63 to 70, Applicant submits that neither Weiss or Vancura individually, nor the gaming device resulting from the combination of Weiss and Vancura anticipate or render obvious that if the symbol is moved to the at least one location before the first location, causing a terminating condition to occur, and if the symbol is moved to the at least one location after the second location, causing the terminating condition to occur. In Weiss, a current round of the bonus game ends when a simulated player lands on either a "Go Home" space or a terminus ("Easy Street") space (Weiss, column 1, lines 50 to 64). Applicant submits that, in Weiss, a simulated player cannot land on a space before the "Home" space (interpreted by the Office Action as the first location of Claim 29) or after the terminus ("Easy Street") space (interpreted by the Office Action as the second location of Claim 29). Additionally, Applicant submits that, in Vancura, the player cannot move to a square before the "Start" square or to a square after the "End" square.

Therefore, Applicant submits that neither Weiss or Vancura individually, nor the gaming device resulting from the combination of Weiss and Vancura anticipate or render obvious (without the benefit of improper hindsight reconstruction) if the symbol is moved to the at least one location before the first location, cause a terminating condition to occur, if the symbol is moved to the at least one location after the second location, cause the terminating condition to occur.

On the other hand, the gaming device of amended independent Claim 29 includes, amongst other elements, at least one memory device which stores a plurality of instructions executable by the processor to cause the processor to operate with the at least one input device and the display device, for each play of a game, to, if the symbol is moved to the at least one location before the first location, cause a terminating condition to occur, if the symbol is moved to the at least one location after the second location, cause the terminating condition to occur.

For at least these additional reasons, amended independent Claim 29 is patently distinguished over Weiss and Vancura, and is in condition for allowance.

Claims 31 to 33 depend directly or indirectly from amended independent Claim 29 and are allowable for these additional reasons given with respect to amended independent Claim 29 and because of the additional features recited in these claims.

Amended independent Claims 9, 15, 34, 38, 45, 55, 63 and 67 each include certain similar elements to amended independent Claim 9. For reasons similar to those additional reasons discussed above with respect to amended independent Claim 29, amended independent Claims 9, 15, 34, 38, 45, 55, 63 and 67 (and dependent Claims 11 to 14, 17 to 20, 35 to 37, 39 to 40, 42 to 44, 46 to 50, 56, 64 and 68) are each patentably distinguished over Weiss and Vancura and are each in condition for allowance.

The Office Action rejected Claims 53 to 54, 57 to 58, 61 to 62, 65 to 66 and 69 to 70 under 35 U.S.C. § 103(a) as being unpatentable over Weiss in view of Vancura, and further in view of Admitted Prior Art. Applicant respectfully disagrees for at least the following reasons.

Page 12 of the Office Action stated that:

> [t]he combination of Weiss and Vancura teaches the invention substantially as described above, but lacks in disclosing operating a game method through a data network including the Internet...On of ordinary skill in the art would have been motivated to modify the combination of Weiss and Vancura in order to allow a player to control gaming devices from a remote location.

Applicant respectfully disagrees. Additionally, Applicant submits that regardless of whether it would have been obvious to modify the combination of Weiss and Vancura

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in order to allow a player to control gaming devices from a remote location, neither Weiss, Vancura or the Admitted Prior Art individually, nor the method of operating a gaming device resulting from the combination of Weiss, Vancura and the Admitted prior art anticipate or render obvious (without the benefit of improper hindsight reconstruction) for each occurrence of the symbol moving to the at least one setback condition location, randomly determining whether to relocate said symbol to one of the locations along the path further from the first location, and if the random determination is to relocate the symbol to one of the locations along the path further from the first location, causing the at least one processor to execute the plurality of instructions to cause the symbol to move to one of the locations along the path further from the first location.

On the other hand, Claims 53 to 54, which depend directly or indirectly from amended independent Claim 51, are directed to a method of operating a gaming device including, amongst other elements, for each occurrence of the symbol moving to the at least one setback condition location, randomly determining whether to relocate the symbol to one of the locations along the path further from the first location, and if the random determination is to relocate the symbol to one of the locations along the path further from the first location, causing the at least one processor to execute the plurality of instructions to cause the symbol to move to one of the locations along the path further from the first location. For at least these reasons, Claims 53 to 54 are patently distinguished over Weiss, Vancura and the Admitted Prior Art and are in condition for allowance.
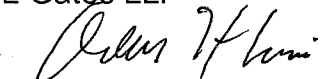
Claims 57 to 58, 61 to 62, 65 to 66 and 69 to 70 each include certain similar elements to Claims 53 and 54. For reasons similar to those discussed above with respect to Claims 53 and 54, Claims 57 to 58, 61 to 62, 65 to 66 and 69 to 70 are each patentably distinguished over Weiss, Vancura and the Admitted Prior Art and are each in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance, which is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

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